



Paper No. 9

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LEGAL DEPARTMENT DL429
INTELLECTUAL PROPERTY ADMINISTRATION
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OFFICE OF PETITIONS

In re Application of
Yakhini, et al.
Application No. 09/938,937
Filed: August 24, 2001
Attorney Docket No. 10003516-1

ON PETITION

This is a decision on the paper titled "Petition", filed April 9, 2002, in which applicant has requested that the Notice of Incomplete Reply mailed March 14, 2002 set a new 30 day period for reply, or alternatively, that the time period for response be tolled. The instant petition is being treated as a petition under 37 CFR 1.183 to waive the requirements for an extension of time fee as set forth in 37 CFR 1.136(a) and 37 CFR 1.17(a).

The petition under 37 CFR 1.183 is DISMISSED.

BACKGROUND:

The above-identified application was filed on August 24, 2001. On September 10, 2001, the Office mailed a Notice to File Missing Parts of Nonprovisional Application. The Notice stated that to avoid abandonment, the following items must be submitted within two months from the mail date of the Notice: (1) an oath or declaration, (2) the surcharge for late filing of the oath or declaration, (3) substitute drawings in compliance with 37 CFR 1.84, and (4) a sequence listing in compliance with 37 CFR 1.821 - 1.825. The Notice stated that extensions of time under 37 CFR 1.136(a) were available.

In response to the Notice to File Missing Parts, on January 22, 2002, applicant filed an executed declaration together with the surcharge for its late filing.¹ Applicants failed to file substitute drawings or a sequence listing. Accordingly, on March 14, 2002, the Office mailed a Notice of Incomplete Reply (Nonprovisional). The Notice reminded applicants that substitute drawings and a sequence listing must be timely filed to avoid abandonment of the application. Furthermore, the Notice stated that the period for reply remained as set forth in the Notice to File Missing Parts.

PETITION UNDER 37 CFR 1.183:

In response to the Notice of Incomplete Reply, applicants have filed substitute drawings and a sequence listing. In addition, applicants have filed the instant petition, arguing that their response to the Notice to File Missing Parts was *bona fide*. Accordingly, applicants assert that the Notice of Incomplete Reply should have set a new 30 day period for reply to submit the substitute drawings and a sequence listing. Applicants maintain that because their response to the Notice to File Missing Parts was mailed more than four months prior to the mailing of the Notice of Incomplete Reply, "it would be manifestly unfair to require that the Applicant petition for an extension of time to reply to the Notice of Incomplete Reply."

37 CFR 1.136(a)(1) states, in relevant part:

If an applicant is required to reply within a nonstatutory or shortened statutory period time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set forth in § 1.17(a) are filed.

The Notice to File Missing Parts set a nonstatutory period for reply of two months. Accordingly, applicant is permitted to extend that period for reply by up to five months by filing a petition for an extension of time and paying the fee as set forth in 37 CFR 1.17(a). As of the date of the instant petition and reply to the Notice of Incomplete Reply, the fee for a five month extension of time was \$1,960.²

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under

¹ This reply was made timely because applicant included a Certificate of Mailing dated November 13, 2001, and because November 12, 2001 fell on a federal holiday.

² 37 CFR 1.17(a)(5).

this section must be accompanied by the petition fee set forth in § 1.17(h).

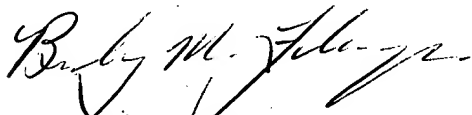
Petitioner has not demonstrated that this is an extraordinary situation where justice requires waiver of the rules. The Notice to File Missing Parts clearly set forth the four items which petitioner was required to timely file to avoid abandonment of the application. In response, petitioner only filed two - an executed declaration and the surcharge for its late filing. Petitioner's reply outright lacked the additional two items required to avoid abandonment - the substitute drawings and a sequence listing. Accordingly, petitioner's reply was on its face **not** a *bona fide* reply.³

Furthermore, the fact that the Notice of Incomplete Reply was mailed more than four months after petitioner filed his response to the Notice to File Missing Parts is not an extraordinary situation.

With his petition and response to the Notice of Incomplete Reply, petitioner submitted a check in the amount of \$110 for a one month extension of time. However, in order for the substitute drawings and the sequence listing to be considered timely, a five month extension of time (\$1,960) is necessary. Accordingly, the difference of \$1,850 has been charged to Deposit Account No. 50-1078, as authorized. In addition, the fee of \$130 for the instant petition under 37 CFR 1.183 has also been charged to petitioner's deposit account.

The application file is being forwarded to the Office of Initial Patent Examination for preexamination processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.



Beverly Flanagan
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³ Contrast petitioner's failure to file substitute drawings and a sequence listing with the situation where an applicant filed these two items, but they failed to comply with the rules.